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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,763

09/22/2003

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DEP759NP

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27777 7590 12/19/2008  
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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

12/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,763	<b>Applicant(s)</b> WASIELEWSKI, RAY C.	
	<b>Examiner</b> Pedro Philogene	<b>Art Unit</b> 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 13-19 and 29-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-19, 29-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/08 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-19, 29-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hershberger et al. (5,470,354) in view of Colleran et al. (5,609,643).

With respect to claims 1, 13, 40, Hershberger et al disclose an instrumented prosthetic knee trial (80) comprising an articulating surface (88,90) a polymer layer at the articulating surface; as set forth in column 7, lines 45-57; a body (84) having curved contoured surface; a sensor array (150,200) between the polymer layer and the curved contoured surface of the body; as best seen in FIGS.3, 26, the sensor array being capable of generating a signal in response to pressure; the polymer layer overlying substantially all the sensor array; a first joint trial having a curved convex articulating surface a second joint trial curved concave articulating surface for receiving the convex

Art Unit: 3733

articulating surface of the first joint; as best seen in FIGS.1-2; the polymer layer having a curved contour substantially following the curved contour of the sensor array, as set best seen in FIG.4, the polymer layer overlying substantially all the sensor array, as best seen in FIGS. 18, 21; the body below the sensor array having a curved concave surface (96) adjacent to the sensor array.

With respect to claims 2-6, 14-19, 41-42, Hershberger et al et al discloses all the limitations; as set forth in column 6, lines 8-67, column 7, lines 1-67, column 8, lines 1-67, column 9, lines 1-67, column 10, lines 1-16; and as best seen in FIGS.1-32.

With respect to claims 29-39, the method steps, as set forth, would have been obviously carried out in the operation of the device; as set forth above.

It is noted that Hershberger discloses that the sensor and polymeric layer are flexible and conform to the flat surface of the body. Hershberger did not teach of a body having concave surface, a sensor having concave and convex surfaces and a polymer layer having concave and convex surfaces, as claimed by applicant. However, these particular configurations of the body the sensor and polymer layer are nothing more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the prosthetic knee of Hershberger et al.

It is further noted that Hershberger did not teach of a body having concave surface, a sensor having concave and convex surfaces and a polymer layer having concave and convex surfaces, as claimed by applicant. However, in a similar art, Colleran et al, provides the evidence of a body (FIGS,5B 10) having a concave

Art Unit: 3733

surfacesurface, a meniscus (14) and an interpositional film having a sensor grid having concave and convex surfaces, column 8, lines 30-45, to achieve high mobility of the knee joint in all directions, with no loss of joint stability.

Therefore, given the teaching of Colleran et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Hershberger et al, as taught by Colleran et al, to achieve high mobility of the knee joint in all directions, with no loss of joint stability.

### ***Response to Amendment***

Applicant's arguments, see Remarks, filed 10/6/08, with respect to the rejection(s) of claim(s) 1-6, 13-19, 29-42 under 103 have been fully considered and are persuasive. Therefore, the rejection in view of Gerber has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Colleran et al. Applicant stated that Hershberger et al teaches use of a curved rocker elements acting against flat smooth surfaces to effect the force sensing function and modifying Hershberger et al by making the flat surfaces curved would change the principle of operation of Hershberger et al. The examiner begs to differ. First, applicant in his disclosure teaches that any shape could have been used for the body, the sensor array and the polymer layer. Second Colleran et al disclose the use of a polymer layer encapsulating a sensor grid positioned between a tibia plateau and condyles. The tibia plateau having convex and concave shape surfaces, the sensor grid follows the contour of the tibia plateau thereby having concave and convex surfaces. Therefore, combining

Art Unit: 3733

the design of the device of Colleran et al with the device of Herschberger to arrive at applicant's claimed invention would have been obvious.

***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
December 17, 2008